



IFW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Franz WOMBACHER et al.

Group Art Unit: 1793

Application No.: 10/555,280

Examiner: P. MARCANTONI

Filed: December 6, 2005

Docket No.: 125239

For: USE OF PHOSPHORUS-OXYGEN ACID ESTERS CONTAINING ALKOXY
GROUPS AS CORROSION INHIBITORS FOR REINFORCED CONCRETE

PETITION TO RESET PERIOD FOR REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Office Action was issued by the U.S. Patent and Trademark Office with a stated mailing date of January 7, 2009, but was not received by Applicants' undersigned representative until February 9, 2009. In accordance with the provisions of MPEP §710.06, Applicants respectfully request that the period for reply be reset to run from February 9, 2009. In support of this Petition, Applicants submit the following:

A) This Petition is being filed within two weeks of receipt of the Office Action at the correspondence address for this application.

B) A substantial portion of the period for reply to the Office Action had already elapsed by the time the Office Action was received by Applicants. In particular, the Office Action was mailed on January 7, 2009, setting a shortened one-month period for response, thus making the extendible due date February 9, 2009, as February 9 fell on a Saturday. Accordingly, by the time the paper was received by Applicants' representative, substantially all of the shortened period for response had elapsed.

C) Although a copy of the envelope that contained the Office Action, attached hereto, and the Office Action state an earlier mailing date, the envelope that contained the Office Action was not received at Applicants' representative's correspondence address until

February 9, 2009. As evidence thereof, attached hereto is a copy of the Office Action, showing the date-stamped receipt date thereon. Applicants' representative routinely date-stamps all correspondence received from the U.S. Patent and Trademark Office in the manner shown on the attached copy. Accordingly, the date-stamp is evidence that the Office Action was not received by Applicants' representative until February 9, 2009.

Accordingly, for all of the reasons set forth above, Applicants respectfully request that the period for reply to the Office Action be reset to run from February 9, 2009, the date on which the Office Action was received by Applicants' representative. Applicants also respectfully request that a formal communication be issued by the Patent Office confirming that the period for response has been reset.

Should there be any questions regarding this Petition, please contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Benjamin S. Prebyl
Registration No. 60,256

JAO:BSP

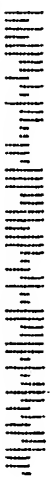
Enclosure:

Copy of the Envelope that contained the Office Action
Date-Stamped Office Action

Date: February 11, 2009

OLIFF & BERRIDGE, PLC
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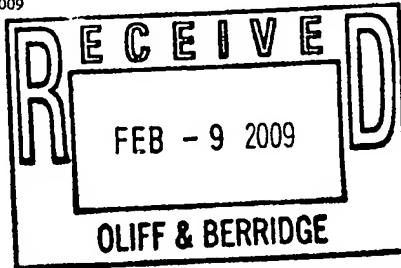


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,280	12/06/2005	Franz Wombacher	125239	4602

25944 7590 01/07/2009
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EXAMINER
MARCANTONI, PAUL D

ART UNIT 1793
PAPER NUMBER

MAIL DATE 01/07/2009
DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RESTRICTION/ELECTION

DUE DATE

FEB - 7 2009

DOCKETED
By ewf on 2/2 2009
By Rmp and 2/9 2009
Oliff & Berridge



Office Action Summary

Application No.	Applicant(s)	
10/555,280	WOMBACHER ET AL.	
Examiner	Art Unit	
Paul Marcantoni	1793	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: PTO STIC search printout.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, drawn to a hydraulic cement composition comprising organic (I),(II),(III), or (IV).

Group II, claim(s) 8-14, drawn to a coating agent for steel comprising the organic (I), (II), (III), or (IV).

Group III, claim(s) 15,19,20, and 21, drawn to a process for coating steel structures with Group I hydraulic cement and organic (I), (II), (III), or (IV).

Group IV, claim(s) 16 and 18, drawn to a process for coating steel structure with Group II (organic coating agent (I),(II),(III), or (IV).

Group V, claim(s) 17, drawn to a process for coating a concrete surface with Group II coating agent (not a direct coating on steel substrate but concrete surface).

Group VI, claim(s) 22, drawn to a process for making a cement comprising mixing organic (I), (II), (III), or (IV) with said cement (not on surface but mixed throughout cement).

The inventions listed as Groups II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 8 is anticipated or obvious over Walter (US 2,574,516-see also answer 37 of 37 in search abstract), Blum et al. (DE 1099257 or GB 895628 abstract-answer 33 or 37), Von Bonin et al. (DE 3530358 abstract-answer 11 of 37), or Rosenfeld (Answer 13 of 37-Russian Article abstract-"Study of mechanism of hydrogen sulfide corrosion...").

All of the above cited abstract references teach a composition that anticipates the general formula (I) for applicants' claim 8. Even if not anticipated, the references above teach the same range of amounts for values such as n, m+K, m, k, etc. Please refer to the structures described in each abstract and it will be readily seen that the structure of

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(I) is within the teaching of this prior art. Note also that Answer 37 of 37 (Walter US '516) even teaches Formula (II) in the abstract. Therefore, the invention of Group II do not relate to a single general inventive concept and no special technical contribution over the prior art. Restriction is proper.

It is noted that the instant examiner works in the cement art so his art would fall into what is Group I. However, it is assumed applicants directly add (I), (II), (III), or (IV) to cement and mix these components. It is assumed Group I does not relate to coating a steel substrate and adding it to cement. It would appear should applicants elect Group I product, potentially Groups II and VI could be rejoined. If Group II product were elected, it would appear the remaining Groups not mentioned could be rejoined to this product. Nevertheless, only an initial PTO STIC Search was performed for the purposes of proper restriction. The examiner has not personally and directly searched manually or electronically the cement subclasses for his own art but it would appear less art may be available with a cement + organic (I) through (IV). Applicants thus may consider electing Group I for examination.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does

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not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the

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above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The examiner can normally be reached on 4-10 Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Marcantoni/
Primary Examiner, Art Unit 1793

**Notice of References Cited**

Application/Control No.

10/555,280

Applicant(s)/Patent Under
Reexamination
WOMBACHER ET AL.

Examiner

Paul Marcantoni

Art Unit

1793

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2,574,516	11-1951	IRWIN HORNSTEIN et al.	558/177
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U	Answer 37 of 37 of STN Chem Abstracts Search:□□□□US 2,574,516 Walter (11/13/51) abstract.
*	V	Answer 33 of 37 of STN Chem Abstracts Search□□□□DE 1099257 (also equiv to GB 895628) Blum et al., Motor Fuel Additives, 2/9/61, abstract.
*	W	Answer 11 of 37 of STN Chem Abstracts Search□□□□DE 3530358 (2/26/87) Von Bonin et al. abstract only.
*	X	Answer 13 of 37 of STN Chem Abstracts Search: "Study of the mechanism of hydrogen sulfide corrosion and devlpmt of inhibitors for gas and petroleum industry", Rosenfeld et al., Rasrab Mer Zashch Met Korros Meshdunar Nauchno Tekh Kunf PRob SEV 3rd (1980), Vol.5, p.75-81. ABSTRACT ONLY.

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.